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10/014,864	12/11/2001	Michael J. Tari	ICOR-004	3644
26137	7590	03/04/2009	EXAMINER	
PATENT DEPARTMENT SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP FOUR TIMES SQUARE NEW YORK, NY 10036			VEZERIS, JAMES A	
ART UNIT	PAPER NUMBER			
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/014,864	<b>Applicant(s)</b> TARI ET AL.
	<b>Examiner</b> JAMES A. VEZERIS	<b>Art Unit</b> 3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 November 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/0256/06)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**Detailed Action**

**Pre-Exam Formalities**

1. Claim 15 has been added. Claims 1, 5, 8, and 14 have been amended.

**Response to Applicant's Arguments**

2. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections- 35 U.S.C. 112 2<sup>nd</sup> Paragraph**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim element "a means for allowing said requestor to trade on said responses" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Examiner notes that there is no algorithm given in the specification to enable one to perform this function. A computer by itself is capable of numerous activities, and as such specific language to how it will perform the claimed invention must be included in the specification.

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or
- (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

6. Claims 1-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner what the last two limitations of the independent claims are claiming. Examiner understands "allowing said requestor to

trade on said two or more responses during a first period" and "at the expiration of said first period, allowing said two or more responders to trade on said two or more responses during a second period" but the limitations that follow are not clear. Since there is no antecedent basis for "said trader" it is unclear what is being claimed. Examiner will review the claims as if the requestor will be allowed to trade during the first period, and all involved will be able to trade in the second period.

7. Claims 1-15 recite the limitation "said trader" in the respective independent claims. There is insufficient antecedent basis for this limitation in the claim. Examiner notes the applicant uses the term "plurality of traders" but fails to define "said traders".

#### **Claim Rejections- 35 U.S.C. 101**

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

**Claim Rejections- 35 U.S.C. 102(e)**

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by US PG-Pub 2002/0169703 to Lutnick et al. (Hereinafter "Lutnick")

**Regarding Claim 1:**

Lutnick teaches a method of electronically trading financial instruments among a plurality of traders, comprising:

receiving a request for proposal ("RFP") on a financial instrument from a requestor; (See Table 2, Passive Side)

receiving two or more responses to said RFP from two or more responders, each said responder providing at least one said response; (See Table 2, Aggressor Side)

transmitting said two or more responses to said requestor; (See Table 2, Aggressor Side) Note a group means more than 1.

allowing said requestor to trade on said two or more responses during a first period, each said trader not being allowed to trade on said two or more responses during said first period unless said trader comprises said requestor; (See Paragraph 67-81)

at the expiration of said first period, allowing said two or more responders to trade on said two or more responses during a second period, each said trader not being allowed to trade on said two or more responses during said second period unless said trader comprises said requestor or said two or more responders. (Paragraph 82-93)

**Regarding Claim 2:**

Lutnick further teaches matching orders at the expiration of said first period and before allowing said two or more responders to trade on said responses. (See Paragraph 67-93) States are mutually exclusive.

**Regarding Claim 3:**

Lutnick further teaches wherein said orders are associated with a bid price or an offer price, said matching orders process further comprising matching crossed orders in which the highest bid prices is higher than the lowest offer price. (Paragraph 120)

**Regarding Claim 4:**

Lutnick further teaches wherein any responses which have not been traded on at the end of said second period are migrated to a general market. (See Paragraph 88 and 89)

**Regarding Claim 5:**

Lutnick further teaches wherein said requestor and said two or more responders are associated with trading groups, said method further comprising transmitting said two or more responses to said trading group associated with said requestor and each trading group associated with said two or more responders, each said trader not receiving said two or more responses unless said trader comprises a trader in said

trading group associated with said requestor or at least one trading group associated with said two or more responders. (See Paragraph 67-81)

**Regarding Claim 6:**

Lutnick further teaches allowing traders in said trading group associated with said requestor to trade on said two or more responses during said first period, each said plurality of traders not being allowed to trade on said two or more responses during said first period unless said trader comprises a trader in said trading group associated with said requestor. (See Paragraph 67-81)

**Regarding Claim 7:**

Lutnick further teaches allowing traders in each said trading group associated with said two or more responders to trade on said responses during said second period. (Paragraph 82-93)

**Regarding Claim 8:**

Lutnick teaches a method of electronically trading financial instruments among a plurality of traders, each trader being associated with one or more trading groups, comprising:

receiving a request for proposal ("RFP") on a financial instrument from a requestor during a first response period, receiving two or more responses to said RFP from two or more responders, each said responder providing at least one said response; (See Table 2, Passive Side)

transmitting said two or more responses to said requestor; (See Table 2, Aggressor Side)

allowing said requestor to trade on said two or more responses during a first exclusivity period, each said plurality of traders not being allowed to trade on said two or more responses during said first exclusivity period unless each said trader is associated with one or more trading groups associated with said requestor, said first response period and said first exclusivity period being allowed to overlap; (See Paragraph 67-81)

at the expiration of said first exclusivity period, allowing said two or more responders to trade on said responses during a second exclusivity period, said traders not being allowed to trade on said responses during said second exclusivity period unless each such trader is associated with one or more trading groups associated with said requestor or is associated with one or more trading groups associated with said two or more responders. (Paragraph 82-93)

**Regarding Claim 9:**

Lutnick further teaches wherein each trader is associated with one or more tradeable structures, said tradeable structures for each said trader being a function of potential traders to a trade. (Paragraph 6)

**Regarding Claim 10:**

Lutnick further teaches said first exclusivity period and said second exclusivity period are co-terminus. (Paragraph 82-93)

**Regarding Claim 11:**

Lutnick further teaches migrating said responses to a general market at the expiration of said second exclusive period.

**Regarding Claim 12:**

Lutnick teaches a system for electronically trading financial instruments among a plurality of traders comprising:

a first workstation associated with a requestor, said first workstation adapted to accept requests for proposal ("RFP") from said requestor; (See Table 2, Passive Side)

a plurality of responder workstations each associated with a responder, each said responder workstation adapted to accept responses to said RFPs from at least one responder; (See Table 2, Aggressor Side)

a server coupled to said first workstation and each said responder workstations, said server adapted to: (See Paragraph 32)

receive said RFP from said first workstation; (See Table 2, Passive Side)

receive two or more responses from two or more responder workstations; (See Table 2, Aggressor Side)

transmit said two or more responses to RFP to said first workstation and each of said plurality of responder workstations from which said server received a response, each said plurality of responder workstations not displaying said two or more responses to RFP unless said responder workstation sent a response to said RFP; (See Paragraph 67-81)

allow said requestor to trade on said responses to RFP during a first period, each said plurality of traders not being allowed to trade on said response during said first period unless each said trader comprises said requestor;

and(Paragraph 82-93)

at the end of said first period, allow said two or more responders to trade

on said responses during a second period, each said plurality of traders not being allowed to trade on said responses during said second period unless each said trader comprises said requestor or said two or more responders. (Paragraph 82-93)

**Regarding Claim 13:**

Lutnick further teaches wherein certain of said first workstation and said plurality of responder workstations functions are implemented in said server. (See Paragraph 32)

**Regarding Claim 14:**

Lutnick further teaches a system for electronically trading financial instruments among a plurality of traders, comprising:

a means for receiving a request for proposal ("RFP") on a financial instrument from a requestor; (See Table 2, Passive Side)

a means for receiving two or more responses to said RFP from two or more responders, each said responder providing at least one said response; (See Table 2, Aggressor Side)

a means for transmitting said two or more responses to said requestor and said two or more responders, each said plurality of traders not receiving said two or more responses unless each said trader comprises said requestor or one or more responders; (See Paragraph 67-81)

a means for allowing said requestor to trade on said responses during a first period, each said plurality of traders not being allowed to trade on said response during

said first period unless each said trader comprises said requestor; (See Paragraph 67-81)

a means for allowing said two or more responders to trade on said responses during said second period at the expiration of said first period, each of said plurality of traders not being allowed to trade on said response during said second period unless each said trader comprises said requestor or said two or more responders. (Paragraph 82-93)

**Regarding Claim 15:**

Lutnick teaches a computer system to electronically trade financial instruments among a plurality of traders, comprising:

receiving at said computer system a request for proposal ("RFP") on a financial instrument from a requestor; (See Table 2, Passive Side)

receiving at said computer system two or more responses to said RFP from two or more responders, each said responder providing at least one said response; (See Table 2, Aggressor Side)

said computer system transmitting said two or more responses to said requestor; (See Paragraph 67-81)

said computer system allowing said requestor to trade on said two or more responses during a first period, each said trader not being allowed to trade on said two or more responses during said first period unless said trader comprises said requestor; and(See Paragraph 67-81)

at the expiration of said first period, said computer system allowing said two or

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more responders to trade on said two or more responses during a second period, each said trader not being allowed to trade on said two or more responses during said second period unless said trader comprises said requestor or said two or more responders. (Paragraph 82-93)

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES A. VEZERIS whose telephone number is (571)270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

3/2/2009

/JAMES A VEZERIS/  
Examiner, Art Unit 3693